

## **REMARKS**

Reconsideration of the present application is respectfully requested. Claims 19 and 30-57 were pending. Applicants previously elected to pursue claims 1-19 and have cancelled claims 20-57. Claims 1 and 10 have been amended. Claims 58-79 have been added. No new matter has been introduced as a result of the amendments and new claims. Thus, claims 1-19 and 58-79 remain pending.

Applicants respectfully submit that newly added claims 58-79 are within the elected claim group.

The Examiner objected to the specification citing the use of trademarks in the specification. The Applicants have accordingly amended the specification to preserve the proprietary nature of the marks to avoid any adverse effects as to the validity of the marks. The Applicants respectfully request withdrawal of the objections.

The Examiner objected to claim 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Accordingly, the Applicants have amended claim 10 to depend from claim 9. The Applicants respectfully request withdrawal of the rejection.

The Examiner rejected claims 1-4, 7, 8, 11, 13, and 16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,017,157 Garfinkle et al. The Applicants respectfully disagree because Garfinkle fails to describe each and every element claimed by the Applicants in claim 1.

Garfinkle describes a method for processing print and digital images of a photographer (Garfinkle, Abstract; Column 1, line 59 to Column 2, line 4). Print

photographs are scanned and transferred/uploaded to a server by a photographer (Garfinkle, Column 2, lines 43-64). The photographer may then access, through an interface, his or her photographs which may be stored on one or more image servers (Garfinkle, Column 3, line 62 to Column 4, line 20). The photographer may then order print copies of the uploaded digital images through the user interface (Garfinkle, Column 9, lines 26-41; Column 10, lines 9-27). In order to complete a transaction, however, a user must "select a fulfillment center 20 which they prefer to use to fulfill all orders placed using the new images" (Garfinkle, column 9, lines 9-12).

Claim 1, as amended, claims:

1. An improved method for an e-commerce retailer to display and sell items of a third party comprising:
  - identifying one or more items of a third party with a unique identifier;
  - associating the unique identifier of the item with an image of the item, said image residing on a computer maintained by the third party;
  - presenting at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party;
  - in response to an order request from the user for one or more items, identifying, based at least in part on said unique identifier, each item requested and an appropriate third party for each requested item;
  - automatically generating an order for each requested item to be transparently sent to the third party.

The Applicants respectfully submit that Garfinkle fails to describe each and every element as claimed by the Applicants. Garfinkle describes a system that allows a photographer to upload their pictures and place orders concerning the uploaded pictures. However, the system of Garfinkle is not transparent to the user because it requires the photographer to select the location that will fulfill his or her order (Garfinkle, column 9, lines 1-13). Thus, Garfinkle fails to describe or suggest "presenting at least

some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party ... and automatically generating an order for each requested item to be transparently sent to the third party.” Therefore, the Applicants submit that Garfinkle fails to anticipate claim 1. Since claims 2-4, 7, 8, 11, 13, and 16 depend from claim 1, and add additional features and limitations, claims 2-4, 7, 8, 11, 13, and 16 are also not anticipated by Garfinkle. The Applicants respectfully request withdrawal of the rejections.

The Examiner rejected claims 5, 9, 10, 12, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of Pat. App. Pub. No. US 2002/0065741 A1 of Baum (hereinafter “Baum”). The Applicants do not admit that Baum is prior art and reserve the right to swear behind the reference at a later date.

The Applicants respectfully submit that neither Garfinkle, nor Baum, alone or in combination, teach or suggest each and every feature as claimed in claims 5, 9, 10, 12, and 17. With respect to claim 1, as discussed above, Garfinkle fails to describe or suggest processing an order request for a third party item including “presenting at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party ... and automatically generating an order for each requested item to be transparently sent to the third party.”

Baum describes a user initiating the distribution of cards from a selected service, where the cards include an image and text associated with the image (Baum, page 8, paragraphs 78-80; Figure 4). Thus, Baum also fails to describe or suggest “presenting

at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party ... and automatically generating an order for each requested item to be transparently sent to the third party.”

Therefore, since neither reference, alone or in combination, teaches or suggests the limitations of claim 1, claim 1 is not rendered obvious by Garfinkle in view of Baum. Furthermore, claims 5, 9, 10, 12, and 17 depend on claim 1, and include additional features and limitations. Thus, claims 5, 9, 10, 12, and 17 are also not rendered obvious by Garfinkle in view of Baum.

The Examiner rejected claims 6 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of Pat. App. Pub. No. US 2002/0077937 A1 of Lyons et al. (hereinafter “Lyons”). The Applicants do not admit that Lyons is prior art and reserve the right to swear behind the reference at a later date.

The Applicants respectfully submit that neither Garfinkle, nor Lyons, alone or in combination, teach or suggest each and every feature as claimed in claims 5, 9, 10, 12, and 17. With respect to claim 1, as discussed above, Garfinkle fails to describe or suggest processing an order request for a third party item including “presenting at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party ... and automatically generating an order for each requested item to be transparently sent to the third party.”

Lyons describes a system where a user buys goods online and picks up goods at a selected pickup location (Lyons, Abstract; page 6, paragraphs 50-52). If the goods

are available at a pickup location, a message is sent to the seller indicating that such goods are available (Lyons, page 5, paragraph 50). However, Lyons does not address transparently providing third party items in this system. Thus, Lyons also fails to describe or suggest "presenting at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party ... and automatically generating an order for each requested item to be transparently sent to the third party."

Therefore, since neither reference, alone or in combination, teaches or suggests the limitations of claim 1, claim 1 is not rendered obvious by Garfinkle in view of Lyons. Furthermore, claims 6 and 14 depend on claim 1, and include additional features and limitations. Thus, claims 6 and 14 are also not rendered obvious by Garfinkle in view of Lyons.

The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of Pat. App. Pub. No. US 2002/0143637 A1 of Shmueli et al. (hereinafter "Shmueli"). The Applicants do not admit that Shmueli is prior art and reserve the right to swear behind the reference at a later date. The Applicants respectfully submit that neither Garfinkle, nor Shmueli, alone or in combination, teach or suggest each and every feature as claimed in claim 15. With respect to claim 1, as discussed above, Garfinkle fails to describe or suggest processing an order request for a third party item including "presenting at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party ... and

automatically generating an order for each requested item to be transparently sent to the third party.”

Shmueli describes a system for facilitating multiple shopping sessions at multiple websites with a portable device that retains and utilizes information from the multiple shopping sessions (Shmueli, page 6, paragraphs 61-65). However, Shmueli does not address a site which sells third party goods. Thus, Shmueli also fails to describe or suggest “presenting at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party ... and automatically generating an order for each requested item to be transparently sent to the third party.” Therefore, since neither reference, alone or in combination, teaches or suggests the limitations of claim 1, claim 1 is not rendered obvious by Garfinkle in view of Shmueli. Furthermore, claim 15 depends on claim 1, and includes additional features and limitations. Thus, claim 15 is also not rendered obvious by Garfinkle in view of Shmueli.

The Examiner rejected claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of U.S. Patent No. 6,505,172 of Johnson et al. (hereinafter “Johnson”). The Applicants respectfully submit that neither Garfinkle, nor Johnson, alone or in combination, teach or suggest each and every feature as claimed in claims 18 and 19.

With respect to claim 1, as discussed above, Garfinkle fails to describe or suggest processing an order request for a third party item including “presenting at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said

computer maintained by the third party ... and automatically generating an order for each requested item to be transparently sent to the third party.”

Johnson describes generating purchase orders that are forwarded to numerous warehouse locations for satisfaction from warehouse inventory (Johnson, Figure 3). However, warehouse inventory location is transmitted back to a purchaser (Johnson, column 10, lines 50-55), and Johnson does not address transparently presenting third party items. Thus, Johnson also fails to describe or suggest “presenting at least some of the images of third party items to a user for on-line commerce, without indicating the items are third party items, said images being retrieved from said computer maintained by the third party ... and automatically generating an order for each requested item to be transparently sent to the third party.”

Therefore, since neither reference, alone or in combination, teaches or suggests the limitations of claim 1, claim 1 is not rendered obvious by Garfinkle in view of Johnson. Furthermore, claims 18 and 19 depend on claim 1, and includes additional features and limitations. Thus, claims 18 and 19 are also not rendered obvious by Garfinkle in view of Johnson.

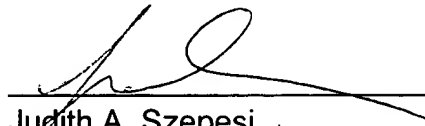
Claims 58-79 have been added without introducing any new matter. The newly added claims similarly claim transparent presentation of third party items. Therefore, Applicants respectfully submit that claims 58-79 are allowable for reasons similar to those set forth above for claims 1-19.

If a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Judith Szepesi at (408) 720-8300.

If there are any additional charges/credits, please charge/credit our deposit  
account no. 02-2666.

Respectfully submitted,  
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